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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/001,960 | 05/03/2002 | Eric B. Stenzel | 12013/58901 | 1392 |

23838 7590 08/07/2003

KENYON & KENYON
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WASHINGTON, DC 20005

EXAMINER

SIRMONS, KEVIN C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3763

DATE MAILED: 08/07/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,960

Applicant(s)

STENZEL, ERIC B.

Examiner

Kevin C. Sirmons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,8,18,21 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5-7,9-12 and 29 is/are allowed.
- 6) ☒ Claim(s) 13,14,16 and 24-26 is/are rejected.
- 7) ☒ Claim(s) 15,17,19,20,23,27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

Applicant's election of Species II, Figs. 2-4, claims 1, 2, 4-7, 9-17 and 19-29 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being dependent upon nonelected claim 3 which is a nonelected species. Claims 21 and 22 are withdrawn as being drawn to nonelected species V, figs. 7 and 8. Election was made **without** traverse in Paper No. 9.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the plunger assembly" and "the first locking collar or the second locking collar." There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the expandable bladder." There is insufficient antecedent basis for this limitation in the claim.

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Claim 26 recites the limitation "the housing." There is insufficient antecedent basis for this limitation in the claim

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kan et al U.S. Pat. No. 6,497,651.

Kan discloses a device comprising: a biocompatible housing having a working channel, an outside surface, a first end, and a second end (figs. 1a-1c); and a first piercing jaw that is moveably coupled to the first end of the housing (11, 12), ends in a piercing tip (11 and 12), and is moveable from a first closed position to a second open position, the second open position allowing access to the working channel of the housing (11 and 12); and as to claim 24, (the examiner considers (31 and 32 to be biasing elements because it biases the jaw between open and close).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakao et al U.S. Pat. No. 5,156,609.

Nakao discloses the method comprising: guiding a first housing having a piercing jaw ending in a piercing tip and a working channel through the body and to a target site in the body (82, fig. 8) urging a second housing from an end of the working channel of the first housing (8A-8E; retracting the second housing into the working channel of the first housing (8E and 8F); and deploying an implant at the target site (91).

Allowable Subject Matter

Claims 1, 2, 5-7 and 9-12 are allowable over the prior art of record.

The following is a statement of reasons for the indication of allowable subject matter: As to claims 1 and 29, the prior art of record discloses the apparatus substantially as claimed at the time the invention was made except for a plunger face or plunger assembly positioned within the inner housing's working passage.

Claims 13, 16 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 15, 17, 19, 20, 23, 27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703)306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.



Kevin C. Sirmons
Patent Examiner
8/4/03